

REMARKS

Applicant hereby cancels claims 32-34. Accordingly, claims 29-31 are currently pending.

Method claims 29-31 stand rejected as anticipated by either Blessinger or Eaton. The Examiner does not dispute that the cited references fail to rely upon or create any limb occluding pressure below systolic, where an indicator indicates pulses corresponding to cardiac contraction of the subject, in order to facilitate needle insertion. Instead, the Examiner has reasoned that these limitations (which are recited in the body of method claim 29) are not relevant to patentability because the limitations relate to an “intended use.” In support of the rejection, the Examiner has relied upon In re Casey, 152 USPQ 235 (CCPA 1967) and In re Otto, 136 USPQ 458 (CCPA 1963), which provide only that intended use is not relevant to patentability of claims for an apparatus or a method of making a device.

In contrast to the claims in Casey and Otto, claims 29-31 are neither apparatus claims nor claims for a method of making a device. Rather claims 29-31 are directed to a method of use of a device. Congress has made clear that intended use is relevant to patentability in a method of use claim, such as claim 29. See 35 U.S.C. §§100(b) (“The term ‘process’ means process, art or method, and includes a new use of a known process, machine”) Simply put, in the context of method claim 29, the Examiner’s position that the “intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art ... [or] a manipulative difference as compared to the prior art” is without merit and should be withdrawn.

As set forth in Applicant’s previous response, claims 29-31 are patentably distinct from the teachings of the Blessinger and Eaton references. In contrast to claim 29, Blessinger does not rely upon or create any limb occluding pressure below systolic where an indicator indicates pulses corresponding to cardiac contraction of the subject. The notion of such a pressure is not

present for any purpose in the reference. The same is true of the Eaton reference which simply discloses a disposable pressure cuff to serve as a tourniquet to control blood pressure during a medical procedure. There is no disclosure in Eaton at all of occluding and maintaining a limb pressure below systolic where an indicator indicates pulses corresponding to cardiac contraction of the subject. There is no disclosure whatsoever in Eaton about any method to facilitate intravenous needle insertion.

In view of the foregoing remarks, it is submitted that all pending claims are in condition for allowance. Accordingly, allowance of all pending claims is requested.

The Commissioner is hereby authorized by this paper to charge any fees due in connection with the filing of the response to Deposit Account No. **50-0310**.

Respectfully submitted,

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By: 

Daniel H. Golub
Reg. No. 33,701
MORGAN, LEWIS & BOCKIUS LLP
1701 Market Street
Philadelphia, PA 19103-2921
Telephone: (215) 963-5055
Facsimile: (215) 963-5299